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Dated: September 27, 2010

Signature: /Weiyang Yang/
Weiyang Yang, Reg. No. 61,637

Docket No.: 64476(46342)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Masaaki Mori *et al.*

Application No.: 10/557,351

Patent No.: 7,763,716

Filed: May 27, 2004

Issue Date: July 27, 2010

For: Antibody Against NPW

Examiner: Michael Pak

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705(d)**

Sir:

This is a request for reconsideration of Patent Term Adjustment (PTA) under 37 C.F.R. § 1.705 (d), or, in the alternative, a Petition for Review of Patent Term Adjustment under 37 C.F.R. §§ 1.181 and 1.704(d), to correct the Patent Term Adjustment for the above-referenced patent application. It is respectfully submitted that the Patent Term Adjustment of 761 days accorded by the Patent Office to the above-referenced issued patent is not correct.

Applicants request appropriate patent term adjustment of this issued patent, pursuant to 37 C.F.R. § 1.705(d). The Director is authorized and requested to charge the appropriate fee under 1.18(e) to our deposit account no. 04-1105. As the patent issued on July 27, 2010, and this Request/Petition is filed within two months of the date of issuance as required by 37 C.F.R. § 1.705(d), this paper is timely filed.

Attached to this Petition as Appendix A is a copy of the Patent Term Adjustment History obtained from PAIR, and as Appendix B is a copy of a Supplemental Application Data Sheet that Applicants filed on April 27, 2010.

STATEMENT OF FACTS

1. The instant patent application was filed on November 18, 2005, as a U.S. national phase application under 35 U.S.C. 371 of International Application PCT/JP2004/007667 that was filed on May 27, 2004, claiming priority to Japanese patent application No. 2003-151577, filed on May 28, 2003. The application was filed together with the executed Declaration and Power of Attorney, Specification including claims and abstract, Sequence Listing, Sequence Statement and diskette, U.S. basic national fees, the priority document, Information Disclosure Statement and related papers.

2. A “Notification to Comply With Requirements For Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosure” was mailed on October 11, 2006. In response, Applicants filed a Sequence Listing (both in paper and diskette) on December 6, 2006.

3. A “Notice of Acceptance of Application under 37 U.S.C. 371 and 37 C.F.R. 1.495” was mailed on January 9, 2007, which indicates that date of receipt of 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) requirements of this application is November 18, 2005.

4. The “Notice of Acceptance of Application under 37 U.S.C. 371 and 37 C.F.R. 1.495” further indicates that the “Date of Completion of All 35 U.S.C. 371 Requirements” for this application is November 28, 2005. Nevertheless, Application note that only a “Raw Sequence Listing Error Report” was generated on November 28, 2005 by STIC Biotechnology Systems Branch (according to PAIR). Thus, Applicants contend that the 371 completion date for this application is November 18, 2005, rather than November 28, 2005, as indicated in the Patent Term Adjustment History obtained from PAIR (Appendix A).

5. A first (non-final) Office Action on the merits (“the Restriction Requirement”)

was mailed on April 4, 2008. As this date was more than 14 months after the filing date of this application, the Office granted 432 days of PTA pursuant to 37 C.F.R. § 1.703(a)(1), as indicated on the copy of the Patent Term Adjustment History. However, Applicants contend that 442 days shall be granted instead, as the application is entitled to November 18, 2005 as the 371 Completion Date.

6. On April 23, 2008, Applicants timely filed a response to the Restriction Requirement mailed on April 4, 2008.

7. Another “Restriction Requirement” was mailed on July 10, 2008, to which Applicants timely filed a response on July 28, 2010. A “Notice of Informal or Non-Responsive Amendment” was mailed on October 30, 2008. In response, Applicants filed a further Response to the Restriction Requirement on January 29, 2009 with a Request for Extension of Time. Applicants’ response to the Restriction Requirement was deemed untimely according to the Patent Term Adjustment History. As such, the Office penalized Applicants in the amount of 185 days of PTA, alleging that the delay was caused by Applicants.

8. A Non-final Office Action was mailed on April 2, 2009, to which Applicants timely filed a response on July 2, 2009.

9. A Final Office Action was mailed on November 12, 2009. Applicants timely filed a response on January 21, 2010.

10. A Notice of Allowance was mailed on April 2, 2010. Before timely paying the issue fees on June 1, 2010, Applicants filed a Supplemental Application Data Sheet (Supplemental ADS; Appendix B) on April 27, 2010. In the Supplemental ADS, only the street address for one of the inventors, Masaaki Mori, was changed. The Patent Term Adjustment History indicates that the Office apparently penalized Applicants in the amount of 92 days of PTA in this application for filing the Supplemental ADS.

11. The patent for the above application issued on July 27, 2010. The Patent Term Adjustment History indicates that the Office awarded Applicants 442 days under 34 U.S.C. 154(a) (A delay), and 606 days under 34 U.S.C. 154(b) (B delay), with 10 days overlapping between A and B delays, and for a total of 1038 days of Patent Office delay. The Patent Term Adjustment History further indicates that that the total PTA in this application is 761 days (evidently calculated as 1038 days of Patent Office delay less 277 days of Applicants' delay (185 + 92), as discussed in paragraphs 7 and 10 above).

12. This patent is not subject to a terminal disclaimer.

13. Upon reviewing the Patent Term Adjustment History, Applicants contend that the deduction of 92 days from PTA as discussed in the above paragraph 10 is improper. According to Clarification of 37 C.F.R. 1.704(c)(10) (1247 Off. Gaz. Pat. Office 111; June 26, 2001), the submission of a paper to "Change of Address" shall not be considered a failure from Applicants to engage in reasonable efforts to conclude processing or examination of an application (*see* MPEP 2732). Applicants contend that the Supplemental ADS was merely a paper to "Change of Address". As such, Applicants are entitled to the 92 days of PTA pursuant to 37 C.F.R. 1.704(c)(10) .

14. Accordingly, Applicants submit that the patent term adjustment of 761 days is incorrect because appropriate PTA should include the 92 days that were incorrectly deducted from the adjustment, and additionally should include 10 days of PTA as the 371 Completion Date of this application is November 18, 2005 (rather than November 28, 2005 as indicated in the Patent Term Adjustment History). Therefore, the correct PTA should be 863 days (the sum of 761 days as indicated in the Patent Term Adjustment History, 92 days that were incorrectly deducted, and 10 days of PTA due to the Office's error in recording the filing date of this application).

RELIEF REQUESTED

Applicants request the patent term adjustment be corrected from 761 to 863 days.

Applicants submit that the instant paper is being filed within two months of the issuance of the patent, as required by 37 C.F.R. §1.705(d). Accordingly, the instant paper is considered timely filed. In the event that this paper should more properly be filed as a Petition for Review of Patent Term Adjustment under 37 C.F.R. § 1.181 and/or §1.705(d), Applicants request that this paper be treated as an appropriate petition and that any necessary fees be charged to our deposit account as indicated below.

The Director is hereby authorized to charge any deficiency, or credit any overpayment, in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105.

Respectfully submitted,

Date: September 27, 2010

Electronic signature: /Weiying Yang/
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